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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/127,112	07/31/98	MARCUS	

EXAMINER	
B	005

ART UNIT	PAPER NUMBER
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ROVNAK, J

DATE MAILED: 09/23/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☑ Responsive to communication(s) filed on 8/26/99, 4/13/99, 7/31/98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☑ Claim(s) 1-32 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☑ Claim(s) 1-32 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☑ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☑ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☑ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

DETAILED ACTION

1. The numbering of claims is not accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 17-45 have been renumbered as 4-32 respectively. Correction for proper dependence of the dependent claims on the renumbered independent claims has been made. Wherein applicant directed the cancellation of claims 1-16, only claims 1-3 have been canceled. Claims 4-16 were not present in the original set of claims.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 4-32 are rejected under the judicially created doctrine of double patenting over claims 1-16 of U. S. Patent No. 5,823,782 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: An object recognition system comprising a hand-held object and a computer for prompting selection of a particular object, for identifying a selected object on a platform, and for providing feedback based on said object.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 4-9, 11-14, 22-23, 25-26, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bogner.

Bogner discloses an object recognition system comprising a plurality of hand-held objects and a microprocessor for prompting selection of a particular object, for identifying a selected object and for providing feedback based on said selected object (col 14 lns 6-32). The applicant is also directed to col 14 starting at ln 46 and especially regarding utilizing the Bogner invention for a spelling game such as Scrabble. Objects bearing indicial marks, specifically alphanumeric characters are inherent with such games. Such games would include the use of tiles or small blocks.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 10, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogner in view of Whitfield. See the above discussion of the disclosure of Bogner and the use of indicial bearing objects. It would have been obvious to one of ordinary skill in the art in view of the teaching of Whitfield that the objects of Bogner could carry braille marks as well as conventional visual indicia.

8. Claims 16-18, 20-21, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogner in view of Csizmadia. Bogner discloses an object recognition system for interacting

with a computer comprising a plurality of hand held objects each including at least one indicial mark (see above discussed Scrabble embodiment) and a platform for receiving a group of two or more objects manually selected from said plurality of objects, said platform capable of conveying to a computer a signal representative of said indicial marks on said group of objects and a relative position of objects of said group on said platform. Bogner does utilize a type of emitter (a resonant frequency emission) within each object for his object identification method and does indicate in col 2 lns 64 and 65 his understanding of and avoidance of the use of costly circuitry in each playing piece, suggesting more complex types of emitters. Moreover, Csizmadia, in the Derwent provided title to his invention, ("Demonstration equipment for game pieces on playing board-has *selective signal emitter working together with signal sensor underneath playing field to transmit state of play*"), clearly teaches the use of a selective signal emitter working with a signal sensor underneath a playing field. It would have been obvious to one of ordinary skill in the art, as suggested from said title of Csizmadia, for an emitter, if not broadly inherent by definition alone in the apparatus providing emission from the Bogner objects, to be included within the plurality of objects of Bogner as an alternate identification means.

Claims 19, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogner in view of Csizmadia and further in view of Whitfield. See the above discussion regarding the obviousness of claim 16. Also see the discussion regarding claims 10, 15 and 24 regarding the obviousness of using braille with the objects of Bogner.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art made of record in the parent application is included here also: Foley, Luxton et al, Lee et al, Chan and Ryan.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Rovnak whose telephone number is (703) 308-3087.

John Edmund Rovnak
Patent Examiner

September 17, 1999